

**REMARKS**

Claims 1-15 are pending in this application. Claims 1-5, 7-11, and 13-15 have been rejected. Claims 6 and 12 have been objected to.

A related patent has issued in the EU. UK Patent No. GB 2391828 issued April 20, 2005. A copy of this UK patent is attached for the Examiner's reference.

The Examiner has rejected claims 1-4, 7, 8 and 15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 1,098,706 to *Bodmer* in view of U.S. Patent No. 4,027,388 to *Fletcher*. Claims 5 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bodmer* and *Fletcher* as applied to claim 2, and further in view of U.S. Patent No. 368,003 to *Polhemus*. Claims 9 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bodmer* in view of *Polhemus*. Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bodmer* and *Polhemus* as applied to claim 9, and further in view of *Fletcher*. Applicants respectfully traverse these rejections and request reconsideration and withdrawal thereof.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See M.P.E.P. § 2142.

The Examiner has failed to establish a *prima facie* case of obviousness at least because there is no suggestion or motivation available to one of ordinary skill in the art to modify *Bodmer* by shortening the blade or lengthening the body. The age of references is

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persuasive evidence of unobviousness of the combination of the teachings when there is evidence that notwithstanding the knowledge of the references, the art tried and failed to solve the problem. See M.P.E.P. 2145. Prior attempts to solve the problem did not include shortening the blade or lengthening the body. Rather, a plastic cover was inserted over the projecting portion of the blade. This plastic sleeve can be easily damaged so that the sleeve is no longer functional, and it can easily be lost. The *Bodmer* reference is almost 100 years old. The *Polhemus* reference is over 100 years old, while *Fletcher* dates back a quarter of a century. The combination of the age of the references and the plastic cover as an attempt to solve the problem is proof of nonobviousness of the invention. Had the invention been obvious to one of skill in the art, it would have been conceived long ago.

In any event, even if the Examiner has established a *prima face* case of obviousness, the objective evidence of nonobviousness is persuasive. "Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence." M.P.E.P. 2141.

As shown in the attached declaration of Iain Campbell, the combined sales for in-store purchases and mail order purchases of the claimed tool since 2002 totals 5714 units. A prior version of a cabinet scraper, the Stanley version, was dropped from the Lee Valley cabinet scraper line when the Lee Valley Cabinet Scraper was introduced in August of 2002. The prior Stanley model included the plastic blade cover described above. In addition, the

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Stanley model includes the features described in *Bodmer*. The Stanley model, a tried and true standard, was selling approximately 250 units annually.

This evidence of commercial success has a clearly established nexus to the claimed invention, as required by M.P.E.P. 716.03 ("An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success."). There is a factually and legally sufficient connection between the sales figures and the claimed cabinet scraper to establish that the evidence is of probative value in the determination of nonobviousness. See *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988). The commercial success of the Lee Valley Cabinet Scraper is directly derived from the invention claimed. Prior cabinet scrapers did not include a durable, impossible to lose, design for protecting the user from injury and for protecting the blade from damage by the blade contact surface. In addition, prior scrapers did not include a chamfer on the clamp bar as described and claimed.

Moreover, the success was not the result of heavy promotion or advertising or any other business event extraneous to the merits of the claimed invention. As shown in the attached declaration of Iain Campbell, during 2002 to 2005, the company maintained generally the same level of promotion and advertising of its products, including the cabinet scraper line. The Lee Valley Cabinet Scraper and the Stanley version are similar cabinet scrapers, except that the Lee Valley tool includes a blade contacting surface having a recessed portion as well as a chamfer on the clamp bar, as described and claimed. Therefore, it is clear that the commercial success of the Lee Valley Cabinet Scraper flows from the functions and advantages disclosed or inherent in the description in the specification.

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Therefore, as demonstrated above, the objective evidence of nonobviousness is persuasive, and the claimed invention is not obvious in view of any of the art cited by the Examiner.

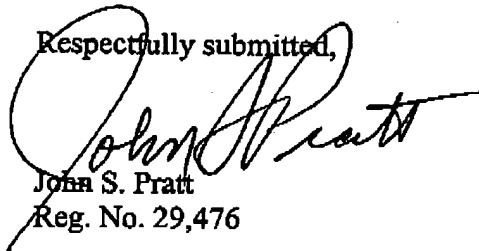
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### CONCLUSION

The application is now in condition for allowance. Such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment to Deposit Account No. 11-0855.

Respectfully submitted,



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